REMARKS

Summary of Office Action

Claims 1-9 and 11-105 are pending in the above-identified patent application.

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims.

The Examiner rejected claims 1-9 and 11-105 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time that the application was filed, had possession of the claimed invention.

The Examiner provisionally rejected claims 1-9 and 11-105 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-115 of copending application No. 09/373,120.

The Examiner rejected claims 1-4, 11-14, 22-36, 65-82, and 94-100 under 35 U.S.C. § 103(a) as being unpatentable over Algie U.S. Patent No. 5,564,977 (hereinafter "Algie") in view of Ueno U.S. Patent

No. 5,746,657 (hereinafter "Ueno"). Claims 5-9, 15-21, 37-64, 83-93, and 101-105 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and Ueno and further in view of Handelman U.S. Patent No. 5,539,450 (hereinafter "Handelman").

Summary of Applicants' Reply to Office Action

The Examiner's objection and rejections are respectfully traversed.

Applicants' Reply To The Rejections Of Claims 1-9 and 11-105 Under 35 U.S.C. § 112

Claims 1-9 and 11-105 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time that the application was filed, had possession of the claimed invention. The Examiner also states that it is not clear where in the application support for the claims, particularly the amended language, may be found. The Examiner's rejections are respectfully traversed.

Applicants' invention, as defined by independent claims 1, 65, and 94, is directed to systems and a method for allowing a user to interactively wager on races using a

user terminal that is remote from any racetrack (see user terminals 122 of FIG. 1 and user terminals 370 of FIG. 29). A plurality of screens having wagering-related content is displayed to the user using the user terminal (see page 30 line 31 to page 31 line 4 and page 31 line 31 to page 32 line 6). The Examiner, in the "Response to Arguments" section of the Office Action, apparently believes that this language refers to multiple display devices. However, the word "screen" is used in the specification in reference to the content (e.g., a menu) being displayed. For example, FIGS. 7-28 and 35-50 show various examples of such screens that may be displayed in connection with the invention. As described in the specification, for example, a user may navigate from screen 458 of FIG. 36 to screen 478 of FIG. 37 by selecting a bet amount. Therefore, support is clearly shown for displaying a plurality of screens using the user terminal.

Independent claims 1, 65, and 94 further specify that one of the plurality of screens includes information on available tracks at which races are to be run (see FIG. 9, page 21 lines 2-4, FIG. 35, and page 52 lines 15-24). The user terminal allows the user to place a wager on a given race that has not been run at one of the available tracks (see page 22 line 23 to page 23 line 4, FIGS. 12-17,

and FIGS. 36-39). Advertising information is displayed on at least one of the plurality of screens (see page 9 lines 5-7, page 38 lines 1-12, FIG. 7, FIG. 26, page 46 lines 18-28, and page 53 lines 27-31).

Applicants' invention, as defined by independent claims 4, 75, and 97, is directed to systems and a method for allowing a user to interactively wager on races using a user terminal that is remote from any racetrack. The user terminal is used to display a screen containing a video advertisement and wagering-related content (see page 46 lines 21-28). The user terminal also allows the user to place a wager on a race that has not been run (see page 22, line 23 to page 23, line 4, FIGS. 12-17, and FIGS. 36-39).

Applicants' invention, as defined by independent claims 5 and 83, is directed to a system and method for allowing a user to interactively wager on races using a user terminal that is remote from any racetrack. A plurality of screens having wagering-related content is displayed using the user terminal. One of the plurality of screens includes information on races that have not been run (see page 22 lines 5-22 and FIGS. 10 and 11) and one of the plurality of screens provides the user with an opportunity to order merchandise (see page 46, line 18 to

page 47, line 2). The user terminal allows the user to place a wager on one of the races that has not been run.

In view of the forgoing remarks, applicants respectfully submit that applicants' invention as defined by independent claims 1, 4, 65, 75, 94, and 97 is fully supported by the specification and drawings. Dependent claims 2, 3, 5-9, 11-64, 66-74, 95, 96, and 98-105 refer to further features that are fully supported by the specification and drawings. Accordingly, applicants request that the 35 U.S.C. § 112 rejection be withdrawn.

Applicants' Reply To The Objection
of The Drawings Under 37 C.F.R. § 1.83(a)

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention. The Examiner contends that "the plurality of screens having wagering related content on a monitor connected to the user terminal and advertising information on at least one of the plurality of screens" are not shown in the drawings. The Examiner's objection is respectfully traversed.

As described above, the word "screen" is used in the specification in reference to content (e.g., a menu) being displayed. Therefore, a plurality of screens having wagering-related content is shown in the screens of

FIGS. 7-28 and 35-50. In addition, advertising information is shown, for example, in FIG. 26, which includes an illustrative handicapping screen that may be "an advertisement for an upcoming seminar on handicapping techniques to be presented at a particular racetrack" (page 38, lines 9-11).

Accordingly, applicants respectfully submit that the drawings show every feature of the invention and request that the objection to the drawings under 37 C.F.R. § 1.83(a) be withdrawn.

The Ueno Reference

Claims 1-4, 11-14, 22-36, 65-82, and 94-100 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie in view of Ueno. Claims 5-9, 15-21, 37-64, 83-93, and 101-105 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and Ueno and further in view of Handelman.

Ueno is not prior art because applicants' priority date is earlier than Ueno's U.S. filing date. However, the Examiner uses Ueno to show an alleged universal fact. The alleged universal fact is "a place to make wagers." While applicants disagree that "a place to make wagers" can be an universal fact under MPEP § 2124,

applicants concede that "a place to make wagers" has been known prior to applicants' priority date.

In fact, the background of applicants' specification refers to such "a place to make wagers." Algie also discloses a display apparatus for a betting parlor (see the abstract of Algie). Therefore, Algie discloses "a place to make wagers." Applicants, therefore, see no need for the Examiner to rely on Ueno for this fact.

Accordingly, applicants will address the rejection of claims 1-4, 11-14, 22-36, 65-82, and 94-100 as over Algie in view of "a place to make wagers" and the rejection of claims 5-9, 15-21, 37-64, 83-93, and 101-105 as being unpatentable over Algie and "a place to make wagers" and further in view of Handelman.

Provisional Obviousness-Type Double Patenting Over Claims 1-9 and 11-115 Of Copending Application No. 09/373,120

Claims 1-9 and 11-105 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-115 of copending application No. 09/373,120. The Examiner should continue to make this "provisional" double patenting rejection as long as there are conflicting claims in these two applications unless the "provisional" double patenting

rejection is the only rejection remaining in this application. If the "provisional" double patenting rejection is the only rejection remaining in this application, then the Examiner should withdraw the rejection and permit this application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application into a double patenting rejection at the time when this application issues as a patent. See MPEP § 804(I)(B).

Applicants' Reply To The Rejections
Of Claims 1-3, 11-31, 65-74, And 94-96

Claims 1-3, 11-14, 22-31, 65-74, and 94-96 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie in view of "a place to make wagers." Claims 15-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and "a place to make wagers" and further in view of Handelman. The Examiner's rejections are respectfully traversed.

Algie, as described above, discloses a display apparatus for displaying racing and parimutuel data at a betting parlor (i.e., "a place to make wagers"). One or more lines of the display apparatus can be used for sponsors' advertisements. In sum, the system of Algie is

merely a display apparatus that is not capable of processing a wager.

The Examiner states that it would have been obvious to apply "a place to make wagers" to the system of Algie in order to permit bettors to make wagers using information supplied by Algie's system. Applicants submit that this is not only obvious, it is the object of Algie's invention. The first stated object of Algie is "to provide a large amount of information in a pleasing and systematic way to bettors ('punters') at a racetrack, betting parlor or similar facility associated with a racetrack in order to excite the bettors into placing bets."

Nevertheless, applicants submit that the combination of Algie and "a place to make wagers" fails to show or suggest applicants' claimed invention. Rather, the combination of Algie and "a place to make wagers" would merely result in a place where wagerers can view information on Algie's display apparatus and place wagers using the existing equipment at the "place to make wagers." This combination, therefore, requires a wagerer to use one system to obtain wagering-related information (i.e., the display apparatus of Algie) and to use another system to place a wager (i.e., the existing equipment at the "place to make wagers").

Accordingly, the combination fails to show or suggest a user terminal for (a) displaying a plurality of screens having wagering related content, wherein one of the screens includes information on available tracks at which races are to be run and (b) allowing the user to place a wager on a given race at one of the available tracks that has not been run as specified in claims 1, 65, and 94.

For at least the foregoing reasons, independent claims 1, 65, and 94 are allowable over Algie in view of "a place to make wagers." Claims 2, 3, 11-31, 66-74, 95, and 96 depend from claims 1, 65, and 94 respectively and are allowable at least because independent claims 1, 65, and 94 are allowable. Applicants, therefore, request that the rejection of claims 1-3, 11-31, 65-74, and 94-96 be withdrawn.

Applicants' Reply To The Rejections
Of Claims 4, 32-51, 75-82, And 97-105

Claims 4, 32-36, 75-82, and 97-100 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie in view of "a place to make wagers." Claims 37-51 and 101-105 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and "a place to make wagers" and further in view of Handelman. The Examiner's rejections are respectfully traversed.

The Examiner contends that the combination of Algie and "a place to make wagers" discloses applicants invention as defined by claims 4, 75, and 97. However, as described above, the combination of Algie and "a place to make wagers" fails to disclose or suggest a user terminal for (a) displaying a screen containing wagering-related content and (b) allowing the user to place a wager on a race that has not been run as specified in claims 4, 75, and 97. Moreover, the combination fails to disclose or suggest using the user terminal to display a video advertisement as specified in claims 4, 75, and 97.

Accordingly, for at least these reasons, independent claims 4, 75, and 97 are allowable over Algie in view of "a place to make wagers." Claims 32-51, 76-82, and 98-105 depend from claims 4, 75, and 97 respectively and are allowable at least because independent claims 4, 75, and 97 are allowable. Applicants, therefore, request that the rejection of claims 1-3, 10-31, 65-74, and 94-96 be withdrawn.

Applicants' Reply To The Rejection
Of Claims 5-9, 52-64, And 83-93

Claims 5-9, 52-64, and 83-93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and "a

place to make wagers" and further in view of Handelman. The Examiner's rejection is respectfully traversed.

Handelman refers to providing additional services to users of a pay television network. In one preferred embodiment, a pay television shopping system is provided. FIG. 34 shows an illustrative shopping display screen. Accounting apparatus is connected to the pay television shopping system for settling shopping debts. In another preferred embodiment, a pay television gaming system is provided. FIG. 35 shows an illustrative gaming display screen. Accounting apparatus is connected to the pay television gaming system for settling gaming debts.

The Examiner contends that it would have been obvious to apply the teachings found in Handelman to the system of Algie and "a place to make wagers" in order to capitalize on the "spur of the moment" want of players seeing products for sale. Contrary to the Examiner's contention, such an extensive modification of Algie is contrary to the purpose of Algie. As described above, Algie's display apparatus provides a large amount of information to the general audience in "a place to make wagers", such as a betting parlor. Because the display apparatus of Algie is simultaneously viewed by multiple wagerers, Algie does not and cannot act in an interactive

manner with regard to individual wagerers. Consequently, Algie fails to disclose or suggest any type of user terminal through which individual wagerers may interact with the display apparatus. Algie's system merely provides a large amount of information to wagerers, who then use a portion of that information to place wagers using existing equipment at the "place to make wagers." Therefore, Algie teaches away from providing a display apparatus with which a user may interact. Modifying Algie with an interactive system of Handelman goes against the teachings of Algie.

Moreover, Handelman refers to a method and system for providing additional services to users of a television network. Algie, as discussed above, is not a television network. Rather, Algie describes displaying wagering information on display boards at "a place to make wagers." The Examiner has failed to provide any objective motivation for extensively modifying the display apparatus of Algie with a television system that provides additional services.

In the "Response to Arguments" section of the Office Action, the Examiner states that attacking the references, which applicants assume refers to Algie and Handelman, individually and not taking into account one of ordinary skill in the art is not a persuasive argument. Applicants respectfully submit that because neither Algie

nor Handelman discloses or suggests any motivation for being combined and because Algie teaches away from such a combination, one of ordinary skill in the art cannot possibly be motivated to apply the teachings found in Handelman to the system of Algie and "a place to make wager."

Accordingly, for at least these reasons, independent claims 5 and 83, and dependent claims 6-9, 52-64, and 84-93, are allowable over Algie, "a place to make wagers," and Handelman. Applicants, therefore, request that the rejection of claims 5-9, 52-64, and 83-93 be withdrawn.

Conclusion

In view of the foregoing, claims 1-9 and 11-105 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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